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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,189	08/06/2001	Dominick V. Stallone	075110.00001	8909

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EXAMINER
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HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/923,189

Applicant(s)

STALLONE, DOMINICK V 

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 2 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-8 is/are allowed.
- 6) ☒ Claim(s) 3-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on August 6, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) = . 6) ☐ Other: .

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-2, drawn to a method of molding a concrete test cylinder, classified in class 264, subclass 109.

II. Claims 3-8, drawn to an apparatus, classified in class 249, subclass 160.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group I and Group II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. MPEP § 806.05(e). In this case the apparatus as claimed could be used to practice another and materially different process, such as a process wherein the concrete is not poured into the cylinder to a position extending above the top portion of the cylinder. Instead, the apparatus

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could be used in a process wherein concrete is poured to a position below the top portion of the cylinder.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation between Examiner Stephen Lechert and Harvey Kauget (Applicant's Representative) on January 26, 2004 a provisional election was made with traverse to prosecute the invention of Group II, claims 3-8. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1 and 2 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. The abstract of the disclosure is objected to because it is too long. The abstract must be less than 150 words. Correction is required. MPEP § 608.01(b).

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 3 and 5 are rejected under 35 U.S.C. 102(a) as being anticipated by Japanese Pub. No. 2000-258316 (hereinafter "JP '316"). Attached to the copy of JP '316 is a computer translation of the document as well as an English abstract. Reference below will be made to the drawings of the document as well as the computer translation.

JP '316 discloses an apparatus for molding a concrete test cylinder. The apparatus comprise a test cylinder mold (2) having a top portion (figure 1). The apparatus also comprises a cap with excretion holes (3), with the cap positioned on the top portion of the test cylinder mold such that excess molding material is excreted through the holes (see translation at ¶ 10). JP '316 further discloses the cap to comprise extension (4) beyond the main circumference of the cap (see figures 2-3). These extensions inherently act as a handle as they could be grip when moving the cap (see figure 1).

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It is noted that claims 3 and 5 recited an intended use for the apparatus, specifically to mold and excrete concrete. It is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. Furthermore, the inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims. In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (CCPA 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963); MPEP § 2115. Thus, in disclosing a mold with all of the claimed structural features including the mold cylinder, cap, and excretion holes for allowing excess molding material to escape the mold, JP '316 anticipates the claimed invention regardless of whether concrete is used in the mold, or excreted from the mold.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '316 in view of De Stasio (U.S. Pat. No. 4,365,784; previously of record).

JP '316 discloses the molding apparatus as described above. JP '316 does not disclose the top portion of the mold to have external threads, and the cap having internal threads for engaging the external threads of the mold.

De Stasio discloses a test cylinder mold. In De Stasio's mold, threaded arrangements are used between a cap (C) member and a mold member (A) for the purpose of creating a seal between these elements (col. 4, l. 66 - col. 5, l. 9). De Stasio further discloses the use of threaded arrangements between mold elements to allow for adjustment between the components (col. 4, ll. 15-27).

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It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the apparatus of JP '316 as such to have used a threaded arrangement between the cap and the top portion of the mold because this would allow for a seal to be created between the cap and mold, as well as allow for the relative adjustment between these two pieces as suggested by De Stasio.

11. Claims 6-8 allowed.

12. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest an apparatus for molding a test cylinder comprising the combination of features recited in claim 6. The closest prior art disclosed by JP '316 is described above. JP '316 does not disclose or suggest a radial through on the cap portion whereby excess molding material is channeled by the radial trough for excretion through the excretion hole in the cap.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The




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examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (571) 272-1151. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Donald Heckenberg  
February 6, 2004